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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,720	09/30/2004	Fred Bishop	03292.101090.28	5719
66569 7590 06/10/2009 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER COPPOLA, JACOB C	
			ART UNIT 3621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/711,720	Applicant(s) BISHOP ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the Remarks and Amendments to the Claims filed on 09 March 2009 (“09 Mar Remarks” and “09 Mar Amendments,” respectively).
2. Claims 1, 3, 5, 6, and 9-11 are currently pending and have been examined.
3. This Office Action is given Paper No. 20090603. This Paper No. is for reference purposes only.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 5, 6, and 9-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Taylor (U.S. 5,578,808 A) (“Taylor”), in view of Russell et al. (U.S. 2004/0044627 A1) (“Russell”), and in further view of Boyer (U.S. 6,880, 037 B2) (“Boyer”).

Regarding Claims 1 and 9

6. Taylor discloses adding, to a first database on a transaction device, a first data set of a first format and a second data set of a second format (*e.g.*, “AMEX” and “VISA”), wherein: the first data set is owned by a first data set owner and the second data set is owned by a second data

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set owner, the first data set owner is distinct from the second data set owner, the first format is different from the second format, and the first data set is stored in accordance with the first format, and the second data set is stored in accordance with the second format; configuring a first method of authentication (“PIN”) corresponding to the first data set and a second method of authentication corresponding to the second data set, wherein the first method of authentication and the second method of authentication are configured by the first data set owner and the second data set owner independently; modifying the first and second data sets; determining that the transaction device is in communication with a read/write device; overwriting, via the read/write device after the determining, at least a portion of the first data set on the transaction device; receiving, after the overwriting, a selection of at least one of the first data set and the second data set to complete a transaction request, wherein: if the first data set is selected, the receiving includes receiving a first secondary identifier indicium corresponding to the first method of authentication, and if the second data set is selected, the receiving includes receiving a second secondary identifier indicium corresponding to the second method of authentication; authenticating, after receiving the selection, the transaction request using the first secondary identifier indicium if the first data set is selected and using the second secondary identifier indicium if the second data set is selected; determining, based on the authenticating, whether the transaction request is approved; and completing, if the determining indicates that the transaction request is approved, the transaction request according to the selection (figs. 1, 4, 6a, and 7 with associated text; c. 5, l. 27-39).

7. Taylor does not directly disclose an RF transaction device; adding, to a second database, a copy of the first data set, the second database being remote from the RF transaction device, and

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being in communication with a user interface via a communication network; modifying, by the first data set owner, the copy of the first data set via the user interface; storing in a queue the modified copy of the first data set; overwriting, via the read/write device after the determining, the first data set on the RF transaction device with the modified copy of the first data set stored in the queue.

8. Russell, however, teaches an RF transaction device (§ 0170).

9. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the RF transaction device of Russell for the transaction device of Taylor. Thus, the simple substitution of one known element for another, producing predictable results, renders the claim obvious.

10. Additionally, Boyer teaches adding, to a second database, a copy of a first data set (“Data stored within the smartcard is read into a memory cache 15 for access by the host processor 16”), the second database being remote from the RF transaction device, and being in communication with a user interface via a communication network; modifying the copy of the first data set via the user interface (“The host processor accesses the cached data and operates thereon to result in modified data”); storing in a queue the modified copy of the first data set (inherent to the processor 16); determining that the RF transaction device is in communication with a read/write device (“smartcard session is initiated when the smartcard 10 is inserted into the host computer system 1”); and overwriting, via the read/write device after the determining, the first data set on the RF transaction device with the modified copy of the first data set stored in the queue (“The

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modified data is then written back to the smartcard memory to replace the data read therefrom”) (fig. 3 with associated text).

11. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the system of Taylor, which allows data set owners to configure and modify their respective data sets, to include the specific process of modifying data sets as taught by Boyer. One would have been motivated to do so because the process of Boyer allows for necessary data set modifications that result from the use of the data set and the transaction device in financial transactions (Boyer, fig. 3 with associated text).

Regarding Claims 3 and 10

12. The combination of Taylor, Russell, and Boyer discloses the method of claim 1, as shown above. Taylor, further, discloses wherein at least one of the first secondary identifier indicium and the second secondary identifier indicium is a personal identifier number (PIN) or a biometric identifier (Taylor, fig. 7 with associated text); and wherein the receiving a selection step further comprises receiving an allocation of the entire transaction request to either the first data set or the second data set (Taylor, fig. 7 with associated text).

Regarding Claims 5, 6, and 11

13. The combination of Taylor, Russell, and Boyer discloses the method of claim 1, as shown above. Russell, further, discloses wherein the step of receiving a selection further comprises receiving an allocation of a first portion of the transaction request to the first data set for transaction completion (Russell, ¶ 0037); wherein the step of receiving a selection further

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comprises receiving an allocation of a second portion of the transaction request to the second data set for transaction completion (Russell, ¶ 0037); and wherein the receiving a selection step further comprises receiving a selection of a plurality of data sets to complete the transaction request (Russell, ¶ 0037).

Application of the Prior Art

14. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Interpretation

15. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision.

16. The Examiner finds that because the examined claims recite neither “step for” nor “means for,” the examined claims fail Prong (A) as set forth in MPEP §2181 I. Because the examined claims fail Prong (A) as set forth in MPEP §2181 I., the Examiner concludes that all examined claims do not invoke 35 U.S.C. §112, 6th paragraph. See also *Ex parte Miyazaki*, 89 USPQ2d 1207, 1215-16 (B.P.A.I. 2008)(precedential).

Response to Arguments

17. Applicants' arguments with respect to the examined claims have been considered but are moot in view of the new grounds of rejection.

18. However, with respect to the Taylor reference, Applicants argue "Apparently, rather than considering processes related to configuring (*e.g.*, overwriting) the data cards, *Taylor* focuses on processes associated with completing a transaction using the card." (emphasis in original). The Examiner agrees that Taylor discloses processes associated with completing a transaction using the transaction device. However, regarding the Applicants' allegations that Taylor lacks processes related to configuring (*e.g.*, overwriting) the data cards, the Examiner respectfully disagrees. In column 5, Taylor explicitly discusses modification of data on the data cards, which involves writing (and obviously overwriting) of data to the transaction device. Additionally, in both figures 1 and 4 (and their associated text) Taylor explicitly describes how data set owners are allowed to configure the data on the transaction devices by accessing the memory area on the device that is assigned to them.

Conclusion

19. Applicants' 09 Mar Amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

20. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is

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not a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112, 1st paragraph written description and enablement, §112, 2nd paragraph indefiniteness, and §102 and §103, prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. The prior art made of record and not relied upon is considered pertinent to Applicants’ disclosure (see attached form PTO-892).

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23. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
June 3, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621